

REMARKS

Status of the Claims:

Claims 1-25 are pending.

Claims 1-13, 15, 16 and 18-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lapstun et al., U.S. Patent Number 7,038,797, hereafter referred to as "Lapstun".

Claims 1-8, 15, 16 and 18-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Orikomio, as admitted prior art see background of application specification, hereinafter referred to as "Orikomio".

According to the foregoing, the claims are amended, and, thus, the pending claims remain for reconsideration, which is respectfully requested. The Examiner's rejections are traversed.

No new matter has been added.

37 C.F.R. § 1.105 Requirements for Information:

The Office Action at page 2 provides a Requirement for Information Under 37 C.F.R. § 1.105. The specific Requirement for Information is on page 3, in which the Examiner requests "of particular interest is information on the Internet inserted-bill supplying service 'Orikomio' which was described by applicant as a prior art. From the information supplied by applicant in the background of the invention Examiner could not differentiate the claimed invention from the prior art."

As noted in the application specification, page 8, lines 4-14, "[t]he present invention is basically distinct from the conventional system, such as 'Orikomio!®', which depends all the advertising costs on the advertisers with all the users being free of charge in that only the limited contractor users that are newspaper subscribers are allowed to view the advertisements, and this makes it possible to positively establish an advertising system utilizing the Internet that closely contact to a local area, and also to successfully carry out the system." In other words, Orikomio discusses a single service in which an advertiser pays to have advertisements on a website where users can view the advertisements for free. Thus, Orikomio discusses a system in which an advertiser pays to advertise on a website and therefore at least fails to disclose, either expressly or inherently, the claimed features of "a first non-privileged service with a first advertisement and users that have a contract[[s]] with the supplier for the first non-privileged service" and "an advertisement preparation unit for preparing an a second advertisement,"

requested by an advertiser, ~~different from said user~~ to be provide as a second privileged service, and for placing said second advertisement on a Web page so that said second advertisement ~~which is a second service provided as a~~ the second privileged service for users that have the contract with the supplier for the first non-privileged service pursuant to said first service providing contract is viewed" as disclosed, for example, in claim 1.

Furthermore, "Orikomio" is submitted in an Information Disclosure Statement, including an English translation thereof, concurrently herewith in response to the 37 C.F.R. 1.105 requirement. It is respectfully requested that the Examiner consider and acknowledge the Information Disclosure Statement (IDS) submitted herewith.

It is believed that this is a complete reply to the Requirement for Information under 37 C.F.R. § 1.105 by clarifying the difference between the claimed invention and Orikomio.

REJECTIONS:

The independent claims are 1, 2 and 18-25, which are anticipatorily rejected over Lapstun.

This rejection is respectfully traversed because Lapstun fails to disclose, either expressly or inherently, the claimed feature of "an advertisement preparation unit for preparing ~~an~~ a second advertisement, requested by an advertiser, ~~different from said user~~ to be provide as a second privileged service, and for placing said second advertisement on a Web page so that said second advertisement ~~which is a second service provided as a~~ the second privileged service for users that have the contract with the supplier for the first non-privileged service pursuant to said first service providing contract is viewed" as recited, for example, in claim 1, 2 and 18-25, since Lapstun only discusses user requested advertising preparation and a subscription service.

Furthermore, since Lapstun only discusses providing a user requested subscription service, Lapstun fails to disclose, either expressly or inherently "a database which registers a supplier ~~for~~ providing a first non-privileged service with a first advertisement and users that have a contract[[s]] with the supplier for the first non-privileged service" as recited, for example, in claim 1. Lapstun discusses "[f]or each section, **the reader optionally specifies** its size, either qualitatively (e.g. short, medium, or long), or numerically (i.e. as a limit on its number of pages), and **the desired proportion of advertising**, either qualitatively (e.g. high, normal, low, none), or numerically (i.e. as a percentage)" (Lapstun, column 24, lines 1-5). In other words, Lapstun discusses that the reader prepares the advertisement requests. Thus, Lapstun discusses an

advertisement request by a user reader and therefore fails disclose, either expressly or inherently, the claimed feature of "an advertisement preparation unit for preparing an a second advertisement, requested by an advertiser, different from said user to be provide as a second privileged service, and for placing said second advertisement on a Web page so that said second advertisement ~~which is a second service provided as a~~ the second privileged service for users that have the contract with the supplier for the first non-privileged service" as recited, for example, in amended claim 1.

Lapstun further discusses "[a] subscriber can draw on two kinds of news sources: those that deliver news publications, and those that deliver news streams. . . . [t]he netpage system uses the Secure Electronic Transaction (SET) system as one of its payment systems. . . . In the netpage system the netpage registration server acts as a proxy for the netpage user (i.e. the cardholder) in SET payment transactions" (Lapstun, column 23, lines 33-35, column 33, lines 14-38). In other words, only a subscriber of the "netpage" system can use the netpage system and thus the netpage system provides no non-privileged access to its services. Thus Lapstun discusses a subscription service and therefore fails to disclose, either expressly or inherently, the claimed feature of "placing said second advertisement on a Web page so that said second advertisement ~~which is a second service provided as a~~ the second privileged service for users that have the contract with the supplier for the first non-privileged service pursuant to said first service providing contract is viewed" as recited, for example, in claim 1.

The present invention has a configuration in which "the second privileged service" (advertising perusal) "is provided to the user at an independent time and by a different medium from the first service," (for example, the subscription to a newspaper). Lapstun does not have such a configuration, but in contrast it seems like the "advertising content" and the "newspaper story content" are laid out in the same page are provided to the user in this layout.

However, Lapstun discusses, at column 24, line 64 to column 25, line 1:

The personalization of the editorial content directly affects the advertising content, because advertising is typically placed to exploit the editorial context. Travel ads, for example, are more likely to appear in a travel section than elsewhere.

Lapstun further discusses, at column 27, lines 50-61:

The netpage publication server automatically lays out the pages of each user's personalized publication on a section-by-section basis. Since most advertisements are in the form of pre-formatted rectangles, they are placed on the page before the editorial content.

The advertising ratio for a section can be achieved with wildly varying advertising ratios on individual pages within the section, and the ad layout algorithm exploits this. ***The algorithm is configured to attempt to co-locate closely tied editorial and advertising content***, such as placing ads for roofing material specifically within the publication because of a special feature on do-it-yourself roofing repairs (emphasis added).

In other words, Lapstun discloses "advertising content" is laid out on the same page and at the same time as the "editorial content" (e.g. the newspaper articles"). Therefore, Lapstun discloses providing a net page publication server which lays out the advertising content and the newspaper story content to the user at the same time on the same medium (i.e. on the same page), and, thus, Lapstun fails to disclose, either expressly or inherently, the claimed feature of "wherein the second privileged service is provided to the user at an independent time and by a different medium from the first service" as recited, for example, in claim 1.

THE ORIKOMIO REJECTION:

Further, the independent claims, 1, 2 and 18-25, which are anticipatorily rejected over Orikomio. This rejection is respectfully traversed because Orikomio at least fails to disclose, either expressly or inherently, the claimed feature of "an advertisement preparation unit for preparing an a second advertisement, requested by an advertiser, different from said usersto be provide as a second privileged service, and for placing said second advertisement on a Web page so that said second advertisement ~~which is a second service~~ provided as a the second privileged service for users that have the contract with the supplier for the first non-privileged service pursuant to said first service providing contract is viewed" as recited, for example, in amended claim 1, since Orikomio only discusses a system in which advertisers pay to have advertisements on a webpage for users to view for free.

As noted in the application specification, page 8, lines 4-14, "[t]he present invention is basically distinct from the conventional system, such as 'Orikomio!®', which depends all the advertising costs on the advertisers with all the users being free of charge in that only the limited contractor users that are newspaper subscribers are allowed to view the advertisements, and this makes it possible to positively establish an advertising system utilizing the Internet that closely contact to a local area, and also to successfully carry out the system." Thus, Orikomio discusses a system in which an advertiser pays to have advertisements on a website and therefore fails to disclose, either expressly or inherently, the claimed feature of "so that said second advertisement ~~which is a second service~~ provided as a the second privileged service for users that have the contract with the supplier for the first non-privileged service" as disclosed, for example, in claim 1.

Dependent claims recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from the independent claims. Withdrawal of the rejection of pending claims, and allowance of pending claims is respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: November 21, 2006

By: 

Mehdi Sheikerz
Registration No. 41,307

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501